

Appl. No. : 09/377,322  
Filed : August 19, 1999

**REMARKS**

The foregoing amendment is responsive to the Office Action mailed on February 14, 2003 (hereinafter “the Office Action”).

I. Provisional Double Patenting Rejection

In the Office Action, the Examiner maintained the provisional rejection of Claims 1, 13, 18, 36, 45 and 53 under the doctrine of obviousness-type double patenting over co-pending Appl. No. 09/377,447. Pursuant to MPEP 804(I)(A), and in view of the pending status of Appl. No. 09/377,447, Applicants again request that the provisional obviousness-type double patenting rejection be held in abeyance.

II. Indefiniteness Rejection of Claims 13 and 14

By the foregoing amendment, Claims 13 and 14 have been amended to correct the informalities noted by the Examiner.

III. Rejections of Claims 13 and 36 under Sections 101 and 112

Claims 13 and 36 have been amended herein to add structural limitations that are believed to overcome the Examiner’s rejections under sections 101 and 112.

IV. Obviousness Rejections of Claim 1-9 and 12-44 and 56

Claims 1-9 and 12-44 stand rejected on obviousness grounds over various references. By the foregoing amendment, the independent claims within this group have been amended as follows:

Independent Claim 1 has been amended to specify that the “second user” (i.e., the user who has purchased the item now being viewed by the first user) has “elected, via a user interface associated with the electronic catalog, to expose said purchase to at least the first user.”

Independent Claim 13 has been amended to specify that the recited item-to-user mapping table reflects “personal preferences specified by said users regarding exposing purchases and contact information to other users,” and to further specify that the recited personalization process “exposes purchases and contact information of the second user to other users in accordance with the personal preferences of the second user.”

Independent Claim 18 has been amended to specify that the “second user” (i.e., the one whose contact information is being provided to the “first user”) is a user who “has opted to

Appl. No. : 09/377,322  
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expose to the first user identities of merchants with which the second user has engaged in business, as reflected within preference data stored for the second user.”

Claim 36 has been amended to specify that the claimed electronic catalog system includes “a user interface through which the users can selectively elect to expose their respective purchase histories to other users.” In addition, the claim now specifies that the recited database stores “preference data indicative of elections made by the users to expose their respective purchase histories to other users,” and that the recited personalization component uses the preference data “to determine whether, and to whom, a given purchase may be exposed.”

These claim amendments are supported by the following, and other, portions of the originally-filed application: Figures 1, 3, 5, 6 and 8; page 4, lines 1-15; page 9, lines 22 and 23; page 10, line 20 to page 11, line 19; page 14, lines 7-21; page 16, lines 4-11; page 19, line 28 to page 20, line 6; page 24, lines 6-25; and Claim 9. In view of these amendments, Applicants submit that Claims 1-9 and 12-44 are patentably distinct from the cited art.

#### V. Obviousness Rejection of Claims 45-52

Independent Claim 45, and corresponding dependent Claims 46-52, stand rejected on obviousness grounds over a combination of the following four references: Bieganski (U.S. Patent No. 6,321,221), Chislenko (U.S. Patent No. 6,041,311), Jacobi (U.S. Patent No. 6,064,980), and Information Week “Just Add People” (collectively “the applied references”). The Examiner also relied on Official Notice in making this rejection.

By the foregoing amendment, independent Claim 45 has been amended to specify that the relevant community is an explicit-membership community that users explicitly join. (See present application at page 3, lines 1-6, which provides examples of types of explicit membership communities that may be used; and page 7, lines 6-9.) As disclosed in the present application, explicit-membership communities may be used to allow users to conveniently control or limit exposure of their respective purchase histories to other users. See, for example, Figure 1 of the present application. To provide consistency with the amendments to Claim 45, several of the corresponding dependent claims have also been amended.

Applicants respectfully submit that none of the cited references discloses or suggests the use of explicit-membership communities in the context of the other limitations of Claim 45. In connection with this feature, the Examiner relies on Information Week’s disclosure of a

**Appl. No.** : 09/377,322  
**Filed** : August 19, 1999

recommendations feature in which a user can submit a specific group of users to a recommendations engine to obtain recommendations that are based on the collective interests of these users. See Office Action at page 9, lines 7-9, and Information Week at page 2, paragraph 4. These groups of users, however, are not “explicit-membership communities” as used within the specification and claims, as they are not explicitly joined by the users.

The applied references also fail to suggest “supplementing a catalog page requested by the first user to include a notification that the item has been purchased by the second user, said catalog page being a page on which the item is displayed,” as recited in Claim 45. In connection with the feature, the Examiner relies on Information Week’s disclosure of the generation of a personalized home page. Office Action at page 9, lines 9 and 10. There is nothing in Information Week to suggest, however, that this personalized home page is a catalog page on which the item is displayed, or that this page is “supplemented” to include the recited notification. An important benefit of supplementing catalog pages in Applicants’ system is that the user notifications are provided in association with items that are already being viewed by the user. (See, for example, Figure 3, which shows how a book detail page may be supplemented for the particular user who is viewing that page.) Thus, for example, the user is not burdened with having to review large numbers of purchase notifications for items that are of little or no interest to the user.

The applied references also fail to suggest notifying one user of purchases made by another user. In this regard, Applicants respectfully disagree with the Examiner’s assertion that this aspect of the invention is obvious in view of Chislenko’s disclosure of notifying users that they share a common interest in a particular recording artist. See Office Action at page 8, lines 9-20, and Chislenko at col. 21, lines 11-26. In this regard, the exposure of a user’s purchases to other users raises privacy issues that do not exist within, and are not addressed by, Chislenko. These privacy issues are addressed in Applicants’ preferred embodiments by providing one or more mechanisms by which users can control whether and to what extent their respective purchases are exposed to others.

In view of these distinctions recited in Claim 45, and the additional distinctions recited in dependent Claims 46-52, Applicants submit that Claims 45-52 are patentably distinct from the applied references.

Appl. No. : 09/377,322  
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VI. Obviousness Rejection of Claims 53-56

Independent Claim 53, and corresponding dependent Claims 54-56, stand rejected on obviousness grounds over the combination of applied references set forth above. In rejecting Claim 53, the Examiner noted that the limitation "maintaining personal address book data for each of a plurality of the users" does not specify who or what maintains the address books. See Office Action at page 9, last line to page 10, line 8. In response, Applicants have amended Claim 53 to add the following language: "wherein the method is performed by a server system that provides functionality for browsing and making purchases from the electronic catalog." In view of this added language, and the other recited distinctions (some of which are discussed above with respect to independent Claim 45), Applicants submit that Claims 53-56, as well as new dependent Claim 63, are patentably distinct from the applied references.

VII. Conclusion

For the foregoing reasons, and the additional reasons set forth in Applicants' prior office action response dated November 11, 2002, Applicants submit that the pending claims are patentable over the applied references, and request that the rejections be withdrawn.

If any issues remain which can potentially be resolved by telephone, the Examiner is invited to call the undersigned attorney of record at his direct dial number of 949-721-2950.

Respectfully submitted,

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